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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,963	10/22/2001	Masataka Hoshino	011354	8557

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EXAMINER

COLEMAN, WILLIAM D

ART UNIT PAPER NUMBER

2823

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,963

Applicant(s)

HOSHINO, MASATAKA

Examiner

W. David Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertin et al., U.S. Patent 6,222,276 B1.
3. Pertaining to claim 1, Bertin discloses a semiconductor device substantially as claimed. See **FIG. 7**, where Bertin teaches a semiconductor device, comprising:

a semiconductor substrate **15** having a first surface and a second surface opposite the first surface, and having a piercing hole piercing there- through from the first surface to the second surface;

an insulating film (not numbered but disclosed in column 2, line 46) formed on the first surface of the semiconductor substrate having the piercing hole extended there-through; and a piercing electrode **44** formed in the piercing hole and extending from the insulating film to the second surface, wherein the piercing hole is formed by using the insulating film as an etching mask; the piercing hole has a first diameter in the insulating film and a second

diameter in the semiconductor substrate which is wider than the first diameter; the piercing electrode has a substantially same diameter as the first diameter along a whole length

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thereof, and an insulating film sleeve lies only between the piercing electrode and an inside wall of the piercing hole in the semiconductor substrate. ( please note that no patentable weight is given to the term “the piercing hole is formed by using the insulating film as an etching mask, since these are device claims). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

“The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature: than when a product is claimed by conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

4. Pertaining to claim 4, Bertin discloses the semiconductor device as claimed in claim 1, wherein the piercing electrode is made of a metal whose main component is a copper 30.
5. Pertaining to claim 5, Bertin discloses a semiconductor integrated circuit device, comprising:

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a support substrate; and

a plurality of semiconductor chips stacked on the support substrate;

the semiconductor chip including a semiconductor substrate; a semiconductor element formed on a first surface of the semiconductor chip;

an insulating film formed on the first surface of the semiconductor chip as covering the

semiconductor element; a multi-layer interconnection structure formed on the insulating film; a

piercing hole formed in the semiconductor chip as piercing from the first surface into the

insulating film through a second surface facing to the first surface; and a

piercing electrode formed in the piercing hole and extending from the first surface to the second surface;

wherein the piercing hole is formed by using the insulating film as an etching mask;

wherein the piercing hole has a first diameter in the insulating film and a second diameter in the

semiconductor chip which is bigger than the first diameter; the piercing electrode has a

substantially same diameter as the first diameter along whole length; and an insulating film

sleeve lies only between the piercing electrode and an inside wall of the piercing hole in the

semiconductor substrate.

6. Pertaining to claim 8, Bertin discloses the semiconductor integrated circuit device as claimed in claim 5, wherein the piercing electrode is made of a metal whose main component is a copper.

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7. Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertin et al., U.S. Patent 6,222,276 B1 as applied to claims 1,4,5 and 8 above, and further in view of Hsu, U.S. Patent 5,481,133.

8. Pertaining to claims 2 and 5, Bertin discloses a semiconductor device substantially as claimed as discussed above. However, Bertin fails to teach the semiconductor device as claimed in claims 1 and 5, wherein the insulating film sleeve is made of an organosiloxane group material, a siloxane hydroxide group material, an organic polymer, or a porous material of the organosiloxane group material, the siloxane hydroxide group material, or the organic polymer. Hsu discloses an insulating film comprised of an organic polymer. In view of Hsu, it would have been obvious to one of ordinary skill in the art to incorporate an organic polymer film into the Bertin semiconductor device because the overlying layer of organic material is deposited over the top of the subordinate substrate (column 3, lines 2-30, please note that the organic polymer is labeled as element 40).

9. Pertaining to claims 3 and 7, the combined teachings fail to teach the semiconductor device as claimed in claims 1 and 5, wherein the insulating film sleeve has a relative permeability of approximately 3.0 and under. Given the teaching of the references, it would have been obvious to determine the optimum thickness, temperature as well as condition of delivery of the layers involved. See *In re Aller, Lacey and Hall* (10 USPQ 233-237) "It is not inventive to discover optimum or workable ranges by routine experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the

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chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Any differences in the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

Appellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness. *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

An Affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

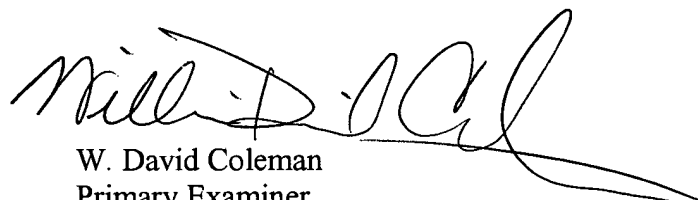
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. David Coleman whose telephone number is 703-305-0004.

The examiner can normally be reached on 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



W. David Coleman  
Primary Examiner  
Art Unit 2823

WDC  
July 4, 2003